

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated January 19, 2007. A Petition for Extension of Time (one month) and the fee therefor are submitted herewith.

Claims 1-16 are pending.

Rejection for Nonstatutory Obviousness-Type Double Patenting

Claims 1-16 are rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-10 of the co-pending Application Serial No. 11/157,331, commonly assigned with the instant application and by the same inventor (“Ohkubo ‘331”). Applicant respectfully traverses the rejection.

The Office Action merely states that claims 1-16 of the instant application are broad enough to read on claims 1-10 of Ohkubo ‘331. What the Office Action describes is the domination of one claim by another. However, domination and obviousness are separate considerations. Domination exists where one claim defines, in broad terms, what would read on a narrower claim of another patent. *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). The courts have held that the mere domination of the scope of one patent claim by the claims of another does not, *per se*, give rise to double patenting. *Id.*

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103”. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the references. *See, In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. *See, Gambio Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir.

2002) (Citing *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). In the instant application, the Office Action cites no evidence of any motivation for one of ordinary skill in the art to modify the subject matter of claims 1-10 in Ohkubo '331 to arrive at the claims of the present invention. Therefore, Applicant respectfully submits that the obviousness type double-patenting rejection is poorly taken.

Moreover, the provisional obviousness-type double patenting rejection is the only rejection in the instant application. However, the MPEP instructs that “The ‘provisional’ double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application **unless that “provisional” double patenting rejection is the only rejection remaining in at least one of the applications.**” MPEP, 8th Ed., Rev. 5, Aug. 2006, § 804(I)(B) (emphasis added). Therefore, being the only rejection in the instant application, Applicant respectfully submits that the provisional double-patenting rejection is no obstacle to allowance, and that the instant application should be passed on to issue.

Conclusion

In light of the foregoing, Applicant respectfully submits that the claims are in condition for allowance.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims and pass this case to issue.

Respectfully submitted,

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ON MAY 17, 2007


MAX MOSKOWITZ
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700